

REMARKS/ARGUMENTS

These remarks are made in response to the Advisory Action of April 17, 2006 (Advisory Action), which followed the Office Action of February 3, 2006 (Office Action). Applicants' response is filed along with a Request for Continued Examination and Request for an Extension of Time.

As an initial matter, Applicants express their sincere appreciation for the Examiner's careful consideration of their previously-submitted amendments and arguments. The Examiner's articulate analysis provided in the Advisory Action greatly assisted Applicants in formulating the amendments presented herein.

The Advisory Action affirmed the rejection of Claims 1-7, 9-23 and 25-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,490,443 to Freeny, Jr., (hereinafter Freeny) in view of U.S. Patent No. 6,498,180 to Borgstahl, *et al.* (hereinafter Borgstahl) and in further view of U.S. Patent Publication No. 2003/0061271 to Pittarelli (hereinafter Pittarelli). Claim 8 was rejected at page 21 under 35 U.S.C. § 103(a) as being unpatentable over Freeny and Borgstahl in further view of U.S. Patent No. 6,577,720 to Sutter (Sutter).

Applicants have further amended each of the independent claims, Claims 1, 12, 18, and 30 to further emphasize certain aspects of Applicants' invention. As discussed herein, the claim amendments are fully supported throughout the Specification. (See, e.g., Specification, p. 14, line 26 – p. 15, line 11.) No new matter has been introduced by virtue of the claim amendments presented.

Applicants' Invention

It may be useful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, typified by Claim 1, as amended, is a method for providing kiosk service offerings. The method can include

retrofitting an existing, publicly-located kiosk with a wireless transceiver, the kiosk previously having lacked wireless communication capabilities but having been configured to communicate over an existing physical communications link. The method also can include configuring the kiosk to provide applications for performing various electronic services over short-range radio communications links to wireless devices in a personal area network (PAN).

The method can further include maintaining a list of available applications for performing the various electronic services. A portion of the available applications can be stored locally within the kiosk, while another portion can be retrieved by the kiosk from an application service provider over the physical communications link. Additionally, the method can include establishing a short-range radio communications link with a wireless device in the PAN, receiving at the kiosk a request from the wireless device for one or more of the available electronic services, and retrieving selected applications for performing the requested electronic services.

The method also can include delivering the requested electronic services to the wireless device in the PAN via the short-range radio communications link. More particularly, services can be provided by conveying one or more retrieved applications. Once conveyed to the wireless device, a retrieved application can perform a requested electronic service by executing within the wireless device independently of the kiosk and other devices. (Specification, p. 14, line 26 – p. 15, line 11.)

The Claims Define Over The Prior Art

Independent Claims 1, 12, 18, and 30, as noted above, were each rejected as unpatentable over Freeny in view of Borgstahl, and further in view of Pittarelli. It is stated in the Advisory Action that Freeny discloses a menu that when conveyed to a wireless device enables a user to select a macro for accessing with the device certain services. It also stated that Borgstahl discloses service interfaces that can be downloaded

by a wireless device so as to provide a capability that was not previously available with the device.

It is noted in the Advisory Action and the Office Action that Freeny does not expressly disclose that the menu or macros are downloaded from a kiosk. It is stated, however, that Borgstahl's service interface, which, when downloaded to the wireless device, allows a user to "control a kiosk" (Office Action, p. 3.)

Borgstahl's service interface operates in the broader context of a "procedure" for performing "a control appliance process." (Col. 9, lines 38-39.) The procedure is explicitly described in Borgstahl:

"Procedure 92 performs a control appliance process 102 to support the controlling of appliances. Tasks 104, 106, and 108 of process 102 are performed to program an appliance peer 20 with personalization data 52 (see FIG. 2). During task 104, a service-providing peer 20 gets personalization data 52 from the connected, service-receiving peer 20 using the service connection. Next, task 106 translates the network compatible personalization data 52 into a format suitable for the specific appliance to be programmed with personalization data 52. It should be noted that not all personalization data 52 available in a service-receiving peer 20 needs to be applicable to all appliances. Thus, task 106 can use as much of personalization data 52 as applies to the specific appliance. After task 106, task 108 causes the appliance to be programmed with the translated personalization data 52. After task 108, program flow returns.

"Tasks 110, 112, 114, and 116 of process 102 are performed to allow a user to easily control an appliance. These tasks can be performed on a PDA, for example, which has a display and user input capability exceeding

the user I/O capabilities typically found on appliances. In this case, an appliance is a service-receiving peer 20 while the PDA is a service-providing peer 20. During task 110, the service-receiving peer 20 uploads an appliance control computer program to the connected service-providing peer using the service connection. Next, during task 112 the service-providing peer 20 executes the just-uploaded computer program. Task 112 causes the service-providing peer 20 to become specifically configured to provide a desirable user interface for the specific appliance being controlled. Next, during task 114 control data are received at the service-receiving peer 20 over the service connection. The control data originated from user input supplied through the control computer program being executed on the service-providing peer 20. After task 114, task 116 controls the subject appliance in accordance with the control data received in task 114. After task 116, program flow returns." (Col. 9, line 38 – Col. 10, line 7.)

As described elsewhere in Borgstahl, both the service-providing peer and the service-receiving peer are wireless devices that are part of a wireless, peer-to-peer data communication network. (See Col. 3, lines 27-35; see also FIG. 1.) As described in the quoted portion, the service-providing peer can be a PDA that receives "personalization data" from the service-receiving peer, which is the appliance. The translation of the personalization data into a format suitable for programming a particular appliance is performed by a task that executes in the PDA (i.e., service-providing peer). (See Col. 8, line 64 – Col. 9, line 3; and FIG. 10.) Once the personalization data is translated, another task that executes in the PDA then programs the appliance (i.e., service-receiving peer) using the translated data. From that point, control of the appliance is effected through an interface that is uploaded from the appliance.

In its complete context, the service that is provided by Borgstahl is the control of an appliance. The service, however, is not performed by the execution of an application that executes entirely within a wireless device once the application has been conveyed to the device from a kiosk. Specifically, if Borgstahl's service-receiving peer is considered to be a kiosk, as in the Office Action, then it follows that the service is performed by execution of separate applications that execute in conjunction with one another, one application being executed in the kiosk (i.e., the service-receiving peer or appliance) and the other – an interface with the kiosk – allowing the wireless device (i.e., the service-providing peer or PDA) to control the kiosk. As acknowledged in the Office Action, the interface is explicitly used to control the kiosk.

It follows from Borgstahl's description that the control application process is not a service that is performed by an application that is conveyed from a kiosk to a wireless device and that executes within the device independently of the kiosk or any other device. In particular, Borgstahl does not teach or suggest conveying an application from a kiosk and providing a requested service by executing a corresponding application entirely within the device to which the application is conveyed independently of the kiosk.

With respect to Freeny, it is stated in the Advisory Action and the Office Action that the menu provided by Freeny enables a device user to access and execute services through a kiosk. Applicants respectfully submit, however, that Freeny does not teach or suggest the features of Applicants' invention. Firstly, as previously argued, Freeny does not teach or suggest a kiosk that conveys executable applications to a wireless device, but rather a device that conveys authorization codes corresponding to applications that are already stored on the wireless device. (See, e.g., Col. 31, line 60 – Col. 32, line 14.)

Secondly, Freeny's menu does not teach or suggest the conveyance to a wireless device of an executable application that executes entirely on the wireless device. Rather, Freeny's menu merely provides access to applications that execute remotely from the

device accessing the applications using a macro selected from a menu. This is explicitly described in a portion of Freeny cited in the Office Action:

"[T]he elements shown in FIG. 6 represent those currently available in most mobile computers with wireless capability such as the Palm Pilot VII wireless note book computer or Nokia 9000 series digital phones. Elements 650 and 660 represent the audio and video (display) functions currently available and element 680 represents the menu select able control functions along with special function elements 630 and 640. The menu select able control functions for example might be a macro for requesting e-mail once the customer is connected to their e-mail service provider. Another control function for example maybe controlled by one of the special function elements 630 and control a customer bank balance request after the customer is connected to their bank. The keyboard elements 610 are shown and are available on every wireless device contemplated to be used with the PPS along with element 650 or 660 or both 650 and 660. That is, every wireless device 40 that can operate with the PPS must have at least a keyboard capability and one form of audio or visual customer communication capability. (Col. 9, lines 39-67.) (Emphasis Supplied.)

A menu for selecting a macro that accesses an e-mail from an e-mail service provider or that accesses a bank balance from a customer's bank is not at all comparable to providing an application to a wireless device from a kiosk, such that the application executes within the wireless device to perform a desired service. The service provided with Freeny's menu is the ability to select a macro that accesses an application residing in a device remote from the wireless device that presents the menu. Accordingly, Freeny also does not teach or suggest either the

conveyance of an application from a kiosk to a wireless device or the performance of a service through the execution of the application within the wireless device independently of the kiosk and other devices.

Additionally, with respect to Freeny, Applicants note that Freeny is cited as disclosing a list of available electronic services provided by a kiosk. Applicants respectfully submit, however, Freeny's menu does not in fact provide an interface for controlling services located on a kiosk. As already noted, Freeny's menu provides a selection of macros for accessing disparate services, such as an e-mail service or a customer account maintained at a bank, running at remote sites. (See Col. 9, lines 45-48; FIG. 6.) Freeny does not teach or suggest that these various services would be provided by a kiosk, as with Applicants' invention. Specifically, nothing in Freeny suggests that these disparate services are located at or comprise a single kiosk through which various service applications can be obtained by a wireless device, as recited in independent Claims 1, 12, 18, and 30.

More particularly, Freeny does not teach or suggest that the various services such as an e-mail service or bank-access service are located at a single publicly-located and fixed-positioned kiosk, as explicitly recited in Claims 1, 12, and 18. Indeed, it is highly unlikely that such would ever be the case. The mere fact that a reference *could* be modified to meet the limitations of a particular invention is never a sufficient basis for establishing the prima facie obviousness of an invention. See *In re Fitch*, 972 F.2d 1260 (Fed. Cir. 1992); see also *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

Accordingly, neither Freeny nor Borgstahl, alone or in combination, teaches or suggests every feature recited in independent Claims 1, 12, 18, and 30. Applicants respectfully submit, therefore, that each of the amended independent claims defines over the prior art. Applicants further respectfully submit that whereas each of the dependent claims depends from one of the amended claims

while reciting additional features, the dependent claims likewise define over the prior art.

CONCLUSION

Accordingly, for the reasons stated herein, Applicants respectfully assert that none of the references, alone or in combination, teach or suggest every feature of independent Claims 1, 12, 18, and 30 and that the claims define over the prior art. Applicants further respectfully assert that, whereas each of the remaining claims depends from one of independent Claims 1, 12, 18, and 30 while reciting additional features, the dependent claims likewise define over the prior art.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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